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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,733	10/01/2001	Taco Van Ieperen	04694.00075	3598

27160 7590 08/30/2005

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EXAMINER
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NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/966,733

Applicant(s)

IEPEREN, TACO VAN

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Claims 1-18 and 21-29 are currently presented and have been examined.

***Response to Amendment***

The affidavit filed on 22 June 2005 under 37 CFR 1.131 is sufficient to overcome the Estrada reference.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 and 21-29 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

In the 37 CFR 1.131 affidavit submitted 23 June 2005, the applicant admitted that the invention was reduced to practice prior to 4 January 2000 (see page 17 of the response filed 23 June 2000, specifically "It is therefore respectfully submitted that the present patent application claims an invention, which was conceived and reduced to practice prior to January 4, 2000."). The Examiner has construed this admission that the invention was "complete" more than 1 year before the filing of

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the application, namely 1 October 2001. See *In re Foster*, \*343< F.2d 980, 987-88, 145 USPQ 166, 173 (CCPA 1965); *Dart Indus. v. E.I. duPont de Nemours & Co.*, 489 F.2d 1359, 1365, 179 USPQ 392, 396 (7th Cir. 1973). Also see MPEP § 715.10. Experimental use "means perfecting or completing an invention to the point of determining that it will work for its intended purpose."

Therefore, experimental use "ends with an actual reduction to practice." *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056, 1061, 12 USPQ2d 1449, 1453 (Fed. Cir. 1989). Actual reduction to practice in the context of an on-sale bar issue usually requires testing under actual working conditions in such a way as to demonstrate the practical utility of an invention for its intended purpose beyond the probability of failure, unless by virtue of the very simplicity of an invention its practical operativeness is clear. *Field v. Knowles*, 183 F.2d 593, 601, 86 USPQ 373, 379 (CCPA 1950); *Steinberg v. Seitz*, 517 F.2d 1359, 1363, 186 USPQ 209, 212 (CCPA 1975). If the invention was actually reduced to practice before being sold or offered for sale more than 1 year before filing of the application, a patent will be barred. *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366-67, 53 USPQ2d 1377, 1379 (Fed. Cir. 2000)

The Examiner submits evidence that the Applicant intended to commercially exploit the completed or "ready for patenting"

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invention more than 1 year prior to the filing of the instant application, creating an "on-sale" bar. One policy of the "on sale" and "public use" bars is the prevention of inventors from exploiting their inventions commercially more than 1 year prior to the filing of a patent application. Therefore, if applicant's precritical date activity is a sale or offer for sale that is an attempt at market penetration, a patent is barred. Thus, even if there is *bona fide* experimental activity, an inventor may not commercially exploit an invention more than 1 year prior to the filing date of an application. *In re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979). The extent of commercial activity which constitutes 35 U.S.C. 102(b) "on sale" status depends upon the circumstances of the activity, the basic indicator being the subjective intent of the inventor as manifested through objective evidence, wherein one of the factors indicative of commercial exploitation is the demonstration of models or prototypes of invention, especially at trade conventions even though no orders are actually obtained. See MPEP 2133.03(e)(1). As indicated by the "CSCW2000 Call for Participation: Demonstrations" ("Call") and "CSCW2000 Conference Program: Demonstrations" ("Demonstrations"), it is clear that the Applicant intended to commercially exploit the invention by communicating to another the features and novelty of the

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invention to register for a demonstration of the invention at a trade convention (see "Call", specifically the section "Submission Requirements"). The evidence also shows that the demonstration is meant for completed or operational systems (see "Demonstrations", specifically "Demonstrations allow us to view novel and noteworthy CSCW systems in action.") Therefore, it also clear that, when registering for the demonstration, the Applicant was aware that a completed or operational invention at the time of the demonstration was required. In view of the Applicant's admission that the invention had been reduced to practice prior to the due date for submission of the registration for the demonstration, namely 21 July 2000 (see "Call"), the Applicant already had the "ready for patenting" invention available before the due date for submission of the registration of 21 July 2001. Since the Applicant shows up on the list of demonstrations, which was last updated on 27 November 2000 (see "Demonstrations"), it is clear that the Applicant must have submitted this information in accordance with the requirements of the submission for registration and communicated this information.

The Examiner also submits extrinsic evidence to show that the invention to be demonstrated embodies the subject matter as claimed, namely "M-Path User's Guide", as published by the

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assignee of the instant application. As shown by "M-Path User's Guide", the features of the claimed invention are embodied within the teachings of the reference.

In conclusion, since the Applicant had reduced the invention to practice prior to 4 January 2000, submitted a registration request prior to 21 July 2000 to demonstrate the invention, the request including the features and novelty of the invention and the intended features to be shown at the demonstration, the Applicant is barred from obtaining a patent under 35 USC 102(b) based on the submitted evidence.

#### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rowebots, Inc. "Meeting 2000: Revolutionary Technology for Everyday Meetings, 2000, 2 pages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

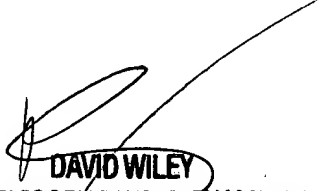
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn

  
**DAVID WILEY**  
SUPERVISORY PATENT EXAMINER  
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